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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/337,113	06/21/1999	ESKO HANNULA	NC273315	8541
30973	7590	12/15/2003	EXAMINER	
SCHEEF & STONE, L.L.P. 5956 SHERRY LANE SUITE 1400 DALLAS, TX 75225			ABDI, KAMBIZ	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 12/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/337,113

Applicant(s)

HANNULA, ESKO

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 14-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

#### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.

2. The prior office actions dated 3 January 2002, 15 January 2003, and 16 June 2003 are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

- Claims 1-4, 6, 8, 10, 14-16, and 20 are amended.
- Claims 1-10 and 14-20 are pending.

#### ***Response to Arguments***

3. Applicant's arguments filed on 26 September 2003 have been considered but with respect to claims, 1 and 15 they are not persuasive for the following reasons:

In response to the applicant's argument in regards to the rejections of claims 1 and 15 under 35 U.S.C. 103 (a), it is clearly disclosed by the references that what has been claimed was anticipated by the prior art of the record. Further, it is clearly disclosed by the Puhl reference that content that is downloaded to the first mobile terminal can be of a third party (See Puhl column 9, lines 22-53, column 11, lines 58-65, column 13, lines 25-68 and column 14, lines 1-12). Also Puhl by the virtue of disclosing "the virtual mall" clearly means that content can be of other origins than what the end user knows of i.e. original creator, or the musician. This again is clearly established by the way of distributors of content through out the art. It is a well known established fact in the industry that you do not have to obtain your content from the original creator, as a matter fact more often than not end users of content get their content from an intermediary or a distribution node. The argument put forward by the applicant regarding the Puhl references concern of security does not render the fact of Puhl reference useless in teaching what the applicant has claimed, As it has been clearly stated in *In re Karlson*, 153 USPQ 184 (CCPA1963).

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4. Additionally, Puhl, Davis, and Harris in combination clearly teach the claimed invention as it has been presented currently and the subject of "peer-providing data files has been clearly thought by Davis reference (See Davis column 6, lines 46-54).

5. Contrary to applicant's assertion the combination of prior art mentioned above clearly teach the steps as currently have been presented in claims 1 and 15. Therefore the prior rejections are maintained.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-10, 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,223,291 to Larry C. Puhl in view of U.S. Patent No. 6,331,972 to Jeffery Martin Harris and U.S. Patent No. 6,282,522 to Vigil M. Davis.

8. As for claims 1 and 15, Puhl discloses an apparatus and method for;  
a recipient-terminal downloading connector selectably operable to effectuate a communication link with the provider mobile terminal when the recipient mobile terminal and the provider mobile terminal are positioned in the manner permitting the communication connectivity there together and selectably operable to effectuate a communication link with the remotely-positioned payment account depository (See Puhl Abstract, figure 3-5, and col. 11, ln. 5-68, col. 12, ln. 1-10, col. 13, ln. 25-68, and col. 14 ln. 1-12);  
a credit payment indicator for containing at least an indicia of creditworthiness of the recipient-terminal user (See Puhl Abstract, figure 3-5, and col. 11, ln. 5-68, col. 12, ln. 1-10, col. 13, ln. 25-68, and col. 14 ln. 1-12); and

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a downloading controller coupled to said payment indicator and to said downloading connector, said downloading controller for permitting said recipient-terminal downloading connector to effectuate the communication link with the provider terminal, thereby to download the content to the recipient mobile terminal if said payment indicator indicates the indicia of creditworthiness to be beyond at least a selected threshold, said downloading controller further, subsequent to downloading of the content to the recipient mobile terminal and removal of the recipient mobile terminal and the provider mobile terminal out of the communication connectivity therebetween,, for causing said recipient-terminal downloading connector to effectuate the communication link with the payment account depository to permit effectuation of debiting of the indicia of creditworthiness to the benefit of the payee entity and, upon debiting, to permit the execution of the content at the recipient mobile terminal (See Puhl Abstract, figure 3-5, and col. 11, ln. 5-68, col. 12, ln. 1-10, col. 13, ln. 25-68, and col. 14 ln. 1-12).

Nevertheless, Puhl does not clearly specify "mobile provider terminal", as recited above. However, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to make both the receiving and provider terminals portable In re Lindberg 93 USPQ 23 (CCPA 1952). Since by doing so, it would make any terminal to be moved about easily and terminals can be characterized as being small and light, making their transportation very easy. (Additionally, Harris does disclose a system that works based on a peer-to-peer communication and transaction).

Further, what Puhl is not explicit about is the nature of the "Smart Card's" value holding and a system that it does utilize to transact the transfer of "electronic cash" from the receiving terminal to the provider terminal. However, both Harris and Davis clearly teach systems that use smart card and cash value stored within them to carry on "electronic cash" transaction (See Harris col. 21, ln. 60-68 and col. 22, ln. 1-55, and Davis figure 32, col. 23, ln. 66-68 and col. 24, ln. 1-23). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the two concepts to have a quicker and easier transaction process over an open network.

Additionally, Puhl is not explicit on the termination of connection between the provider terminal and the recipient terminal and initiating a new communication between the recipient terminal and the payment/license server. Davis clearly teaches necessitation of the communications amongst the parties

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(See Davis figures 4-9 and 11A-11D and associated texts) and how the communication is controlled by controller applications. It would have been obvious to one having ordinary skill in the art at the time the current invention was made to terminate a communication between portable provider terminal and portable recipient terminal to establish a new communication with a payment/license server in order to make payments and obtain usage rights and keys. This would keep the lines of communication clear for the portable devices and their limited capabilities to communicate amongst multiple devices. A cell phone for example has a limited capability to communicate with multiple devices at once. Therefore, it would be necessary to disconnect from one device to communicate with another device.

9. As for claim 2, Puhl, Harris and Davis disclose the apparatus of claim 1, further; what Puhl does not clearly disclose is that the provider mobile terminal comprises a provider-terminal downloading connector and wherein said recipient-terminal downloading terminal is engageable the provider-terminal downloading connector. It would be inherent in this type of peer to peer systems for both peers to have the same relevance, they must be able to communicate, this communication would require certain connectivity either physical or not. Puhl describes a method that uses WAP to establish communication between the two parties. (See Puhl col. 9, ln. 1-8 and ln. 22-28).

But, Puhl does not clearly specify "mobile provider terminal", as recited in claims 1 and 15. However, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to make both the receiving and provider terminals portable In re Lindberg 93 USPQ 23 (CCPA 1952). Since by doing so, it would make any terminal to be moved about easily and terminals can be characterized as being small and light, making their transportation very easy. (Additionally, Harris does disclose a system that works based on a peer-to-peer communication and transaction).

10. As for claim 3, Puhl, Harris and Davis disclose the apparatus of claim 2, further; what Puhl does not clearly disclose is that a point-to-point connection is formed between the provider mobile terminal and the recipient mobile terminal when the provider-terminal downloading connector engages with said recipient-terminal downloading connector. As for Puhl not clearly specifying "mobile

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provider terminal", as recited in claims 2 and 1. However, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to make both the receiving and provider terminals portable. In re Lindberg 93 USPQ 23 (CCPA 1952). Since by doing so, it would make any terminal to be moved about easily and terminals can be characterized as being small and light, making their transportation very easy, which in turn would lead to the capability of out most availability of the provider terminal a distribution point. (Additionally, Harris does disclose a system that works based on a peer-to-peer communication and transaction).

Even though Puhl does not explicitly teach this but it is obvious to one having ordinary skill in the art at the time the current invention was made, that two entities peered as such in this invention must be able to exchange (push and pull or down-load) information between them. This transaction between terminals need to be controlled (See Puhl Abstract, figure 3-5, and col. 11, ln. 5-68, col. 12, ln. 1-10, col. 13, ln. 25-68, and col. 14 ln. 1-12).

11. As for claim 4, Puhl, Harris and Davis disclose the apparatus of claim 3, further; what Puhl does not clearly disclose is that the provider-terminal downloading connector and said recipient-terminal downloading connector each comprise executable downloader programs. But Puhl is clear of at least one of the terminals having an executable program at the point of contact to manage the information transfer and other related execution of task regarding a transaction (See Puhl Abstract, figure 3-5, and col. 11, ln. 5-68, col. 12, ln. 1-10, col. 13, ln. 25-68, and col. 14 ln. 1-12). Additionally, it is well known to one having ordinary skill in the art at the time the current invention was made, that any two terminals in order to interact with each other they must have to communicate, thus it requires the two terminals to have the appropriate software and modes of linkage be it physical or otherwise, for communication and downloading digital assets.

12. As for claim 5, Puhl, Harris and Davis disclose the apparatus of claim 1, further; what Puhl clearly discloses, is that said recipient-terminal downloading connector comprises an executable downloader program, executable at the recipient mobile terminal (See Puhl Abstract, figure 3-

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5, and col. 11, ln. 5-68, col. 12, ln. 1-10, col. 13, ln. 25-68, and col. 14 ln. 1-12). Additionally, it is well known to one having ordinary skill in the art at the time the current invention was made, that any two terminals in order to interact with each other they must have to communicate, thus it requires the two terminals to have the appropriate software for communication and downloading digital assets.

13. As for claim 6, Puhl, Harris and Davis disclose the apparatus of claim 1, further; Puhl does disclose that the content executable at the provider mobile terminal comprises a selected application program selected from amongst a plurality of application programs and wherein said recipient terminal downloading connector is actuatable by the recipient-terminal user to select the selected application program from amongst the plurality of application programs (See Puhl Abstract, figure 3-5, and col. 11, ln. 5-68, col. 12, ln. 1-10, col. 13, ln. 25-68, and col. 14 ln. 1-12).

14. As for claim 7, Puhl, Harris and Davis disclose the apparatus of claim 1, further; what Puhl does not clearly disclose is that payment indicator is releasably engageable with the recipient mobile terminal, coupled to said downloading controller when engaged with the recipient mobile terminal. What Puhl is not explicit about is the nature of the SIM card present in the client system and what content does it carry. In addition, Davis is clear about the role of the Smart Cards in "online" transactions and how it can expedite the speed of the transaction. (See Davis figure 1 and 2, and col. 7, ln. 5-35). However, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to incorporate Davis's teaching within Puhl's invention for flexibility of using smart cards rather than just a SIM card.

15. As for claims 8-9 and 18-19, Puhl, Harris and Davis disclose the apparatus of claims 1, 7, and 17, further; what Puhl does not clearly disclose is that the recipient-terminal further comprises a card-member receiving platform and wherein said payment indicator comprises a payment card containing the indicia of the creditworthiness of the recipient-terminal user stored thereon, said payment and releasably



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positionable at the card-member receiving platform to be coupled to said downloading controller when positioned thereat

What Puhl is not explicit about in the above claim is how the Smart Card reader and writer in its portable terminal associated with the rest of the system (See Puhl col. 11, ln. 5-68, col. 12, ln. 1-10) and the nature of the "Smart Card's" value holding (Software Token) and a system that it does utilize to transact the transfer of "electronic cash" from the receiving terminal to the provider terminal. However, both Harris and Davis clearly teach systems that use smart card and cash value stored within them to carry on "electronic cash" transaction and the system to make it easy to read and interact with the (See Harris col. 21, ln. 60-68 and col. 22, ln. 1-55, and Davis figure 32, col. 7, ln. 5-35, col. 11, ln. 14-25, col. 23, ln. 66-68 and col. 24, ln. 1-23). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the two concepts to have a quicker and easier transaction process over an open network with more flexibility and choices.

16. As for claims 10 and 16, Puhl, Harris and Davis disclose the apparatus of claims 1 and 15, further;

what Puhl is not explicit about is that the content has cost indicia associated therewith, the cost indicia indicating a charge associated with execution of the content and wherein said downloading controller compares the cost indicia associated with the content with the indicia of creditworthiness contained at the payment indicator to determine whether the indicia of creditworthiness is at least the selected threshold (See Puhl col. 11, ln. 5-68, col. 12, ln. 1-10). It would have been obvious to one having ordinary skill in the art at the time the current invention was made that in order to render services based on a monetary transaction a system has to be able to check and verify the level of credit available to a transaction to be rendered and make a comparison to see if the available level of monetary funds available would be sufficient to cover the cost of service or content to be provided.

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17. As for claims 14 and 20, Puhl, Harris and Davis discloses the apparatus of claim 1, further; what Puhl does not clearly disclose is that the content further has payment account depository indicia associated therewith, the payment account depository indicia indicating the location to which said recipient-terminal downloading connector is to effectuate the communication link and crediting the payee entity for execution of the content at the recipient mobile terminal (See Puhl col. 13, ln. 25-68 and col. 14, ln. 1-12). However, both Harris and Davis clearly indicating the system and method of directing the receiving terminal to provide a third party (Payment Server) of the transaction and the associated information therewith (See Harris col. 23, ln. 65-68 and col. 24, ln. 1-22, and Davis col. 12, ln. 39-61 and col.16, ln. 52-57). Therefore, It would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the teachings of Harris and Davis with Puhl's to achieve greater security and authentication of monetary transaction. (Additionally, it is well known that e-commerce systems do keep track of the customer transactions as specific data related to the transaction within a data base unique to that consumer and based on the information obtained through communications between the two terminals is captured as certain transactions take place. Accordingly the cost associated with the transactions are debited to the recipient of the services credit data just as it is credited to the providers data where ever it might have been stored).

18. As for claim 17, Puhl, Harris and Davis disclose the apparatus of claim 15, further; what Puhl is not explicit about is that the additional operation, prior to said operation of determining, of providing the indicia of creditworthiness to the recipient mobile terminal (See Puhl col. 11, ln. 5-68, col. 12, ln. 1-10). It would have been obvious to one having ordinary skill in the art at the time the current invention was made that in order to render services based on a monetary transaction a system has to be able to check and verify the level of credit available to a transaction to be rendered and make a comparison to see if the available level of monetary funds available would be sufficient to cover the cost of service or content to be provided. In Addition it is well understood in the art that for any transaction to take place or any transfer of digital assets to occur a determination is made for credit worthiness of the purchaser.

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What Puhl fails to be explicit about in the above claim is how the Smart Card reader and writer in its portable terminal associated with the rest of the system (See Puhl col. 11, ln. 5-68, col. 12, ln. 1-10) and the nature of the "Smart Card's" value holding (Software Token) and a system that it does utilize to transact the transfer of "electronic cash" from the receiving terminal to the provider terminal. However, both Harris and Davis clearly teach systems that use smart card and cash value stored within them to carry on "electronic cash" transaction and the system to make it easy to read and interact with the (See Harris col. 21, ln. 60-68 and col. 22, ln. 1-55, and Davis figure 32, col. 7, ln. 5-35, col. 11, ln. 14-25, col. 23, ln. 66-68 and col. 24, ln. 1-23). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the two concepts to have a quicker and easier transaction process over an open network with more flexibility and choices.

19. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

### **Conclusion**

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

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advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks  
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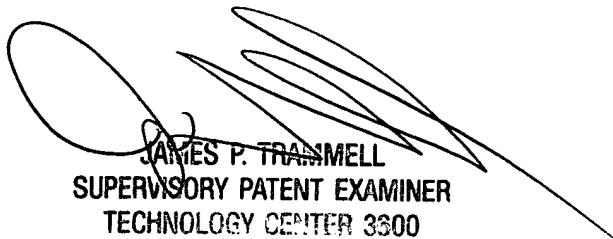
(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

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Hand delivered responses should be brought to:

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7th floor receptionist, Arlington, VA, 22202**

**Abdi/K  
December 10, 2003**

  
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